

ATTORNEY DOCKET NO.
062891.0508
Confirmation No.: 8274

PATENT APPLICATION
10/004,320

1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Balaji S. Holur et al.
Serial No.: 10/004,320
Filing Date: October 30, 2001
Group Art Unit: 2617
Confirmation No.: 8274
Examiner: Bryan J. Fox
Title: *Method and System for Managing Pushed Data at a Mobile Unit*

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Appellant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed October 19, 2006, finally rejecting Claims 1-33, all of which are pending in this case. Appellant filed a Notice of Appeal on January 19, 2007. The Commissioner is hereby authorized to charge the statutory fee of \$500.00 to Deposit Account No. 02-0384 of Baker Botts L.L.P.

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Confirmation No.: 8274

PATENT APPLICATION
10/004,320

Table of Contents

<u>Real Party in Interest</u>	3
<u>Related Appeals and Interferences</u>	4
<u>Status of Claims</u>	5
<u>Status of Amendments</u>	6
<u>Summary of Claimed Subject Matter</u>	7
<u>Grounds of Rejection to be Reviewed on Appeal</u>	8
<u>Argument</u>	9
<u>Conclusion</u>	14
<u>Appendix A: Claims on Appeal</u>	15
<u>Appendix B: Evidence</u>	22
<u>Appendix C: Related Proceedings</u>	23

ATTORNEY DOCKET NO.
062891.0508
Confirmation No.: 8274

PATENT APPLICATION
10/004,320

3

Real Party in Interest

This application is currently owned by Cisco Technology, Inc., as indicated by an assignment recorded on October 30, 2001, in the Assignment Records of the United States Patent and Trademark Office at Reel 012361, Frame 0215.

ATTORNEY DOCKET NO.
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PATENT APPLICATION
10/004,320

Related Appeals and Interferences

There are no known appeals or interferences, which will directly affect or be directly affected by or have a bearing on the Board's decision regarding this appeal.

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PATENT APPLICATION
10/004,320

Status of Claims

Claims 1-33 are pending in this application. Claims 1-33 are rejected pursuant to a Final Office Action mailed October 19, 2006, and are all presented for appeal. All pending claims are shown in Appendix A.

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Status of Amendments

All amendments submitted by Appellant were entered by the Examiner before the issuance of the Final Office Action mailed October 19, 2006.

Summary of Claimed Subject Matter

Independent Claim 1 recites a method for managing pushed data at a mobile unit. The subject matter of Independent Claim 1 is generally illustrated by FIGURES 1 and 5: FIGURE 5 being a flowchart that summarizes an operation of the mobile unit. (See Specification at pages 36-37, which outlines this call flow.) The method includes receiving an out-of-band message at a mobile unit (element 14 of FIGURE 1) and analyzing the message to determine if it contains pushed data. (See Step 508 of FIGURE 5.) The pushed data reflects a server initiated data transfer that is based on predetermined criteria. The method also includes determining, if the message contains pushed data, whether the data is appropriate for a session currently being hosted by the mobile unit. In addition, the method includes posting the data to the session if the data is appropriate for the session. (See Steps 512-536 of FIGURE 5 and pages 27-28 of the Specification.) The determining and posting operations cooperate in order to achieve a filtering function for the mobile unit such that only selected data is posted to the session. The other Independent Claims are analogous and recite similar limitations.

Grounds of Rejection to be Reviewed on Appeal

Appellant requests that the Board review the Examiner's rejection of Claims 1-4, 6-7, 9-12, 14-15, 17-20, 22-23, 25-28, 30-31, and 33 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 6,119,014 issued to Alperovich et al. (hereinafter "*Alperovich*") in view of U.S. Patent No. 5,705,995 issued to Laflin et al. (hereinafter "*Laflin*"), and further in view of WO 99/35778 issued to Kadyk (hereinafter "*Kadyk*").

Appellant also requests that the Board review the Examiner's rejection of Claims 5, 13, 21, 29, and 32 under 35 U.S.C. §103(a) as being unpatentable over *Alperovich* in view of *Laflin* and *Kadyk* as applied to Claims 4, 12, 20, and 25, and further in view of what is well known in the art. Appellant also requests that the Board review the Examiner's rejection of Claims 8, 16, 24, and 32 under 35 U.S.C. §103(a) as being unpatentable over *Alperovich* in view of *Laflin* and *Kadyk* as applied to Claims 1, 9, 17, and 25 above, and further in view of U.S. Publication No. 2001/0041571 A1 issued to Yuan (hereinafter "*Yuan*").

Argument

The Examiner's rejections of Claims 1-33 based on 35 U.S.C. §103 is improper, and the Board should withdraw the rejections for the reasons given below.

Applicant respectfully reminds the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

As an initial matter, the Examiner has failed to meet his burden with respect to the third criteria of non-obviousness, as none of the references cited by the Examiner discloses all of the limitations of the pending claims.

Turning to the merits of the Examiner's three and four-reference §103 rejections, *Alperovich* (the main reference) fails to disclose any system associated with "**analyzing** the message to determine if it contains pushed data, wherein the pushed data reflects a server initiated data transfer that is based on predetermined criteria" and then "**determining**, if the message contains pushed data, whether the data is appropriate for a session currently being hosted by the mobile unit" and further "**posting** the data to the session if the data is appropriate for the session" as is recited by Independent Claim 1. These steps are indelibly linked together. For example, if a given reference fails to disclose "pushed data" (such as is the case with *Alperovich*), then there could not be any system that can **analyze** if the message contains pushed data or **determine** whether the [pushed] data is appropriate for the session.

For virtually all of the above-identified limitations, the Examiner relies on *Alperovich*. The portions of *Alperovich* cited by the Examiner fail to disclose these elements and various other limitations, which are fundamental to the operations of the pending subject matter. For example, *Alperovich* does not even discuss management of pushed data, which appears odd considering that this is the Examiner's main reference.

¹ See M.P.E.P. § 2142-43.

Referring now to *Laflin*, this reference discloses a dumb device, which merely receives a message and stores the message by category (or sub-category). (See Abstract of *Laflin*.) After the message is categorized, *Laflin* is unable to post the data to the session if the data is appropriate for the session, as is recited in Independent Claim 1. The Examiner offers *Laflin* for the “pushed data” element, which is absent from *Alperovich*. But *Alperovich* already fails to teach the above-identified limitations and, thus, is inherently flawed in its own respect. Moreover, there is nothing in *Yuan* that offers this missing disclosure, nor is there anything in *Alperovich* that is combinable with *Laflin* or *Yuan* that would inhibit the patentability of Independent Claim 1. Indeed, evaluating the references more closely reveals that *Yuan* and *Laflin* do not provide any subject matter relevant to the patentability of the pending claims, as both *Yuan* and *Laflin* fail to offer a teaching, a suggestion, or a disclosure associated with the above-identified limitations.

Moreover, no reference of record can analyze the message to determine if it contains pushed data, determine if the message contains pushed data, whether the pushed data is appropriate for a session currently being hosted by the mobile unit, and post the pushed data to the session if the data is appropriate for the session such that these operations (collectively) perform a filtering function for the mobile unit. This important function is recited in Independent Claim 1, but not accounted for in any of the references. The filtering function empowers the mobile device to make an evaluation of whether or not the selected data is appropriate for the session. Without such an ability, there is no control provided to the mobile unit for which type of data propagates to the end users. Undesired data consumes resources, augments processing loads, and hampers the end user’s experience. There is nothing in any reference that provides this significant filtering function for the mobile device.

In addition, missing from all such references is the requisite motivation or suggestion to combine these elements to achieve the filtering operation of the present invention. This lack of suggestion or motivation is a clear violation of the first prong of non-obviousness, of which the Examiner is intimately familiar. Applicants wish to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, the proposed *Alperovich-Laflin-Kadyk* combination is still improper because the Examiner has not shown the required suggestion or motivation in *Laflin*, *Alperovich*, *Kadyk* or in the

knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.² Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.³ Nothing in *Alperovich* or in *Laflin* or in *Kadyk* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.⁴ Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under the M.P.E.P.⁵ and governing Federal Circuit case law.⁶ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.⁷

² M.P.E.P. § 2143.01 (emphasis in original).

³ *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

⁴ If “common knowledge” or “well known” art is being relied on to combine the references, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

⁵ See M.P.E.P. § 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

⁶ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

⁷ See M.P.E.P. §2145.

Thus, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.⁸ The factual inquiry whether to combine references must be thorough and searching.⁹ This factual question cannot be resolved on subjective belief and unknown authority;¹⁰ it must be based on objective evidence of record.¹¹

Furthermore, the Examiner is precluded from modifying the combined teachings of *Alperovich* and *Laflin* and *Kadyk* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.¹² The fact that the modification is possible or even advantageous is not enough.¹³ A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹⁴

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The combinations of *Alperovich* and *Laflin* and *Kadyk* would not be capable of performing the operations required by the claimed invention. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability to achieve the filtering function. With the filtering operation, the mobile device can make an evaluation of whether or not the selected data is appropriate for the session. Absent a filtering operation, there is no control provided to the mobile device for which type of data propagates to the end users. Undesired data consumes resources, augments processing loads, and hampers the end user's experience. There is nothing in any reference that provides a coherent filtering function for the mobile device.

⁸ See *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986).

⁹ See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

¹⁰ See *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ 2d 1430, 1434 (Fed. Cir. 2002).

¹¹ *Id.* at 1343, 61 USPQ 2d at 1434.

¹² *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

¹³ See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

¹⁴ *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed *Alperovich-Laflin-Kadyk* combination would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

Assuming, for the sake of argument, that *Laflin* and *Alperovich* are analogous art, and that there is the required suggestion or motivation to combine *Alperovich* with *Laflin* and *Kadyk*, the proposed *Alperovich-Laflin-Kadyk* combination would still fail because the limitations specifically recited in the pending claims are not disclosed in each of the references, as evaluated extensively above. Accordingly, such an argument is flawed in that it does not satisfy the third criterion of obviousness, as identified in the analysis above.

For at least these reasons, Independent Claim 1 is clearly allowable over the proposed combinations. In addition, Independent Claims 9, 17, 25, and 33 include a limitation that is similar, but not identical, to that of Independent Claim 1. Accordingly, these Independent Claims are also allowable over the proffered combinations using a similar rationale. Additionally, the dependent claims corresponding of these Independent Claims are also allowable for analogous reasons.

Thus, all of the pending claims have been shown to be allowable, as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these pending claims.

ATTORNEY DOCKET NO.
062891.0508
Confirmation No.: 8274

PATENT APPLICATION
10/004,320

14

Conclusion

Appellant has demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is hereby authorized to charge the statutory fee of \$500.00 to Deposit Account No. 02-0384. In addition, the Commissioner is hereby authorized to charge any amount required and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant


Thomas J. Frame
Reg. No. 47,232

Date: March 19, 2007

Customer No. **05073**

Appendix A: Claims on Appeal

1. (Previously Presented) A method for managing pushed data at a mobile unit, the method comprising:

receiving an out-of-band message at a mobile unit;

analyzing the message to determine if it contains pushed data, wherein the pushed data reflects a server initiated data transfer that is based on predetermined criteria;

determining, if the message contains pushed data, whether the data is appropriate for a session currently being hosted by the mobile unit; and

posting the data to the session if the data is appropriate for the session, wherein the determining and posting operations cooperate in order to achieve a filtering function for the mobile unit such that only selected data is posted to the session.

2. (Original) The method of Claim 1, further comprising:

analyzing the data to determine if it is static or dynamic; and

storing the data if it is static.

3. (Original) The method of Claim 2, wherein analyzing the data comprises determining whether an indicator in the data indicates that the data is dynamic.

4. (Original) The method of Claim 2, further comprising:

determining, if the data is dynamic, whether to store the data; and

storing the dynamic data if it should be stored.

5. (Original) The method of Claim 4, wherein determining whether to store the data comprises determining whether an indicator in the data indicates that the data should be stored.

6. (Original) The method of Claim 4, further comprising:
determining whether a trigger has been met for stored dynamic data;
determining, if a trigger has been met, whether the data is appropriate for a session currently being hosted by the mobile unit; and
posting the data to the session if the data is appropriate.

7. (Original) The method of Claim 2, further comprising:
detecting the initiation of a session;
determining whether stored static data is appropriate for the session being initiated;
and
posting the stored data to the session being initiated if the stored data is appropriate.

8. (Original) The method of Claim 1, wherein the data is received out-of-band in a vendor-specific extension of an agent advertisement message.

9. (Previously Presented) A system for managing pushed data at a mobile unit, comprising:

a computer-processable medium; and
logic stored on the computer-processable medium, the logic operable to:
receive an out-of-band message at a mobile unit;
analyze the message to determine if it contains pushed data, wherein the pushed data reflects a server initiated data transfer that is based on predetermined criteria;
determine, if the message contains pushed data, whether the data is appropriate for a session currently being hosted by the mobile unit; and
post the data to the session if the data is appropriate for the session, wherein the determining and posting operations cooperate in order to achieve a filtering function for the mobile unit such that only selected data is posted to the session.

10. (Original) The system of Claim 9, wherein the logic is further operable to:
analyze the data to determine if it is static or dynamic; and
initiate storing the data if it is static.
11. (Original) The system of Claim 10, wherein analyzing the data comprises
determining whether an indicator in the data indicates that the data is dynamic.
12. (Original) The system of Claim 10, wherein the logic is further operable to:
determine, if the data is dynamic, whether to store the data; and
initiate storing the dynamic data if it should be stored.
13. (Original) The system of Claim 12, wherein determining whether to store the
data comprises determining whether an indicator in the data indicates that the data should be
stored.
14. (Original) The system of Claim 12, wherein the logic is further operable to:
determine whether a trigger has been met for stored dynamic data;
determine, if a trigger has been met, whether the data is appropriate for a session
currently being hosted by the mobile unit; and
post the data to the session if the data is appropriate.
15. (Original) The system of Claim 10, wherein the logic is further operable to:
detect the initiation of a session;
determine whether the stored static data is appropriate for the session being initiated;
and
post the stored data to the session being initiated if the stored data is appropriate.
16. (Original) The system of Claim 9, wherein the data is received out-of-band in
a vendor-specific extension of an agent advertisement message.

17. (Previously Presented) A system for managing pushed data at a mobile unit, comprising:

means for receiving an out-of-band message at a mobile unit;

means for analyzing the message to determine if it contains pushed data, wherein the pushed data reflects a server initiated data transfer that is based on predetermined criteria;

means for determining, if the message contains pushed data, whether the data is appropriate for a session currently being hosted by the mobile unit; and

means for posting the data to the session if the data is appropriate for the session, wherein the determining and posting operations cooperate in order to achieve a filtering function for the mobile unit such that only selected data is posted to the session.

18. (Original) The system of Claim 17, further comprising:

means for analyzing the data to determine if it is static or dynamic; and

means for storing the data if it is static.

19. (Original) The system of Claim 18, wherein analyzing the data comprises determining whether an indicator in the data indicates that the data is dynamic.

20. (Original) The system of Claim 18, further comprising:

means for determining, if the data is dynamic, whether to store the data; and

means for storing the data if it should be stored.

21. (Original) The system of Claim 20, wherein determining whether to store the data comprises determining whether an indicator in the data indicates that the data should be stored.

22. (Original) The system of Claim 20, further comprising:
means for determining whether a trigger has been met for stored dynamic data;
means for determining, if a trigger has been met, whether the data is appropriate for a session currently being hosted by the mobile unit; and
means for posting the data to the session if the data is appropriate.

23. (Original) The system of Claim 18, further comprising:
means for detecting the initiation of a session;
means for determining whether stored static data is appropriate for the session being initiated; and
means for posting the stored data to the session being initiated if the stored data is appropriate.

24. (Original) The system of Claim 17, wherein the data is received out-of-band in a vendor-specific extension of an agent advertisement message.

25. (Previously Presented) A system for managing pushed data at a mobile unit, comprising:

a service access manager operable to receive an out-of-band message at a mobile unit and analyze the message to determine if it contains pushed data, wherein the pushed data reflects a server initiated data transfer that is based on predetermined criteria; and

a data push manager operable to determine, if the message contains pushed data, whether the data is appropriate for a session currently being hosted by the mobile unit and to post the data to the session if the data is appropriate for the session, wherein the determining and posting operations cooperate in order to achieve a filtering function for the mobile unit such that only selected data is posted to the session.

26. (Original) The system of Claim 25, wherein the data push manager is further operable to analyze the data to determine if it is static or dynamic and to initiate storing the data if it is static.

27. (Original) The system of Claim 26, wherein analyzing the data comprises determining whether an indicator in the data indicates that the data is dynamic.

28. (Original) The system of Claim 26, wherein the data push manager is further operable to determine, if the data is dynamic, whether to store the data and to initiate storing of the dynamic data if it should be stored.

29. (Original) The system of Claim 28, wherein determining whether to store the data comprises determining whether an indicator in the data indicates that the data should be stored.

30. (Original) The system of Claim 28, wherein the data push manger is further operable to:

- determine whether a trigger has been met for stored dynamic data;
- determine, if a trigger has been met, whether the data is appropriate for a session currently being hosted by the mobile unit; and
- post the data to the session if the data is appropriate.

31. (Original) The system of Claim 26, wherein the data push manger is further operable to:

- detect the initiation of a session;
- determine whether stored static data is appropriate for the session being initiated; and
- post the stored data to the session being initiated if the stored data is appropriate.

32. (Original) The system of Claim 25, wherein the data received out-of-band in the vendor-specific extension of an agent advertisement message.

33. (Previously Presented) A system for managing pushed data at a mobile unit, comprising:

a service access manager operable to:

receive an out-of-band message at a mobile unit, and

analyze the message to determine if it contains pushed data, wherein the pushed data reflects a server initiated data transfer that is based on predetermined criteria;

a data push manager operable to:

determine, if the message contains pushed data, whether the data is appropriate for a session currently being hosted by the mobile unit,

post the data to the session if the data is appropriate for the session, wherein the determining and posting operations cooperate in order to achieve a filtering function for the mobile unit such that only selected data is posted to the session,

analyze the data to determine if it is static or dynamic,

initiate storing the data if it is static,

determine, if the data is dynamic, whether to store the data,

initiate storing the dynamic data if it should be stored,

detect the initiation of a session,

determine whether stored static data is appropriate for the session being initiated,

post the stored static data to the session being initiated if the stored data is appropriate,

determine whether a trigger has been met for stored dynamic data,

determine, if a trigger has been met, whether the dynamic data is appropriate for a session currently being hosted by the mobile unit, and

post the dynamic data to the session if the data is appropriate.

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10/004,320

22

Appendix B: Evidence

NONE

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PATENT APPLICATION
10/004,320

23

Appendix C: Related Proceedings

NONE